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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,135	06/01/1999	CHRISTIAN LAROQUE	Q054622	8820

7590 08/26/2004

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EXAMINER

PHILPOTT, JUSTIN M

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/323,135

Applicant(s)

LAROQUE ET AL.

Examiner

Justin M Philpott

Art Unit

2665

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

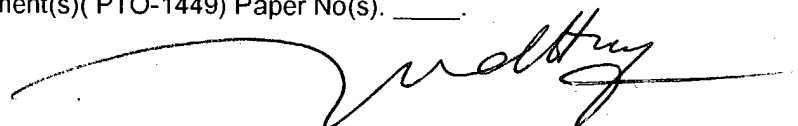
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____



HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive.

Specifically, applicant argues that Kabay fails to teach "an interpreter to produce a signaling configuration upon receiving a predetermined character string corresponding to an order to send a signaling message" as recited in independent claim 1 and, similarly, in independent claim 3. However, Kabay clearly teaches such a limitation as discussed in the previous office action and repeated herein. That is, Kabay teaches an interpreter to produce a signaling configuration (e.g., signaling message, such as Initial Address Message, comprising service trigger conditions, see col. 7, line 2 - col. 8, line 11) upon receiving a predetermined character string (e.g., dialed number, DN) corresponding to an order to send a signaling message. More specifically, applicant further argues (page 3, first paragraph to page 4, second paragraph) that Kabay fails to teach an embodiment of applicant's invention which is discussed in applicant's specification, wherein the embodiment comprises a plurality of features which are not recited in applicant's claims. Such limitations include: a "predetermined order is always the same regardless of the type of signaling message", an interpreter which "encapsulates the signaling message according to the type of channels available at the switch" and "can decide which type of channel to use" and wherein "the recipient switch adds a 'received' instruction to the signaling message and then, checks to see if the message is addressed to the switch", and "predetermined instructions which are the same for all different types of calls". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., features recited in page 3 first paragraph to page 4, second paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's argument is not persuasive.

Further, applicant argues (page 4, third paragraph to page 6, first paragraph) that Poon fails to teach the deficiencies which applicant has argued are evident with Kabay. However, as discussed above, Kabay is not deficient with respect to the limitations recited in applicant's claims. Thus, applicant's argument is moot.

Still further, applicant argues (page 6, second and third paragraphs) that Kabay in view of Poon fail to teach the limitations recited in dependent claim 2. With respect to this argument, applicant states that the detection step performed by Kabay would be unnecessary in view of Kabay's intended use of the invention. However, as recited in MPEP 2144, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In *re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In *re Dillon*, 919 F.2d 688, 15 USPQ2d 1897 (Fed. Cir. 1990). Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Kabay in view of Poon clearly teach the limitations recited in dependent claim 2 as discussed in the previous office action. Thus, applicant's argument to the contrary is not persuasive..